

REMARKS

In the present response, claims 1-4, 10, 12, 16-27, and 29-31 have been amended, and claim 11 has been cancelled. New claims 37 - 100 have been added. Claims 1 -10 and 12 - 100 remain in the present application.

Claims 1-35 stand rejected under 35 U.S.C. 103(a), and claims 24-27 and the drawings were objected to by the Examiner.

Claim 1 was amended to essentially include the limitations of cancelled claim 11. Claims 2-4, and 12 were amended to make grammatical changes. Claim 10 was amended to depend from claim 1. Claims 16, 18, 19, 20, 21, 22, 23, 24, and 25 were amended to delete the unnecessary limitation "discrete" in the terms "discrete switch" and "discrete display". Claims 24, 25, 26, and 27 were amended to replace the acronyms DND and MUR with their respective meanings, do-not-disturb and make-up-room, as suggested by the Examiner. Claims 29 and 30 were amended to delete the unnecessary limitation "electromagnetic". Claim 31 was amended to clarify that the switch assembly comprises an electronic thermostat. No new matter was added.

1. Drawing Objections

The Examiner has objected to the drawings because, in Figure 11, all numeric blocks 30, 32, 36, 50, 52, 54, and 56 are not labeled with descriptive labels. Applicants have amended Figure 11 to include the descriptive labels. A copy of the amended Figure 11 is attached hereto.

2. Claim Objections

The Examiner has objected to claims 24 through 27 because the acronyms DND and MUR are not spelled out. Applicants have amended claims 24 through 27 to replace the acronyms DND and MUR with their respective meanings. Accordingly, Applicants respectfully request that this objection be reconsidered and withdrawn.

3. Claim Rejections under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1 through 35 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,236,303 to Wagner et al. (hereinafter "Wagner") in view of U.S. Patent No. 3,964,058 to Winston (hereinafter "Winston"). The Examiner's rejection of these claims under 35 U.S.C. 103(a) as being unpatentable over Wagner in view of Winston is hereinafter traversed and reconsideration requested for the following reasons.

First, Applicants have amended claim 1 to include the limitations of cancelled claim 11. Claim 1, as amended, requires a doorbell chime disposed on the switch assembly, with the doorbell chime including a speaker for audio output upon actuation of the doorbell button. Regarding this limitation, the Examiner recites that "Winston discloses the doorbell chime (13) includes a speaker for audio output", and cites Fig. 1, Col. 2 lines 1-15 and lines 37-40 in support. However, establishing a prima facie case of obviousness requires that all elements of the invention be disclosed in the prior art. *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). In this case, neither Wagner nor Winston, alone or in combination, teach or suggest a doorbell chime disposed *on the switch assembly*. In Wagner there is no doorbell chime; in Winston, a bell 13 of the type including two large, suspended bells, is mounted on a wall (Fig. 1). Even if the bell 13 of Winston were considered to be a "speaker", as recited in amended claim 1, Winston does not teach or suggest disposing the bell 13 on the switch assembly. Instead, Winston teaches mounting the large bell 13 high on a wall (Fig. 1).

Moreover, even assuming that all elements of an invention are disclosed in the prior art, an Examiner cannot establish obviousness by locating references that describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would have impelled one skilled in the art to do what the patent applicant has done. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. Int. 1993). The references, when viewed by themselves and not in retrospect, must suggest the invention. *In Re Skoll*, 187 U.S.P.Q. 481 (C.C.P.A. 1975). In this case, one skilled in the art would not be motivated to combine the bell 13 of Winston with the switch assembly

10 of Wagner. In Wagner, the switch assembly 10 is a small plate that is preferably mounted near the door to the hotel room or near a hotel bed or telephone (Col. 3, lines 37-41). On the other hand, the type of bell 13 taught by Winston includes two large, suspended bells (Fig. 1). It is well known that this type of bell is typically mounted high on a wall so that the suspended bells are not contacted by the occupants of the room. Thus, the bell 13 of Winston would not be usable with the switch assembly 10 of Wagner, which must be accessible by the occupants of the room. Accordingly, there is nothing in either Winston or Wagner that would have impelled one skilled in the art to provide a doorbell chime disposed on the switch assembly, with the doorbell chime including a speaker for audio output upon actuation of the doorbell button, as recited in Applicant's claim 1.

In sum, there is no motivation to combine Winston and Wagner to arrive at Applicant's claimed invention of a doorbell chime disposed on the switch assembly, with the doorbell chime including a speaker for audio output upon actuation of the doorbell button. If Winston and Wagner were combined, the result would be a switch assembly 10 mounted near the door to the hotel room or mounted near a bed or telephone in the hotel room and an indicating assembly 30 mounted exterior to the hotel room as taught by Wagner, and a bell 13 mounted high on a wall in the hotel room as taught by Winston. Thus, even if Winston and Wagner were combined, this combination fails to teach or suggest each and every limitation of Applicant's claimed invention. Accordingly, for at least these reasons, Applicants respectfully request that the Examiner's rejection of claim 1, and claims 2-10 and 12-35 which depend therefrom, under 35 U.S.C. 103(a) as being unpatentable over Wagner in view of Winston be reconsidered and withdrawn.

While claim 16 should be allowable as depending from what should now be an allowable independent claim 1, claim 16 is also allowable as neither Wagner nor Winston, alone or in combination, teach or suggest an indicating assembly that includes a switch actuated from outside of the room to determine a condition of the room, as recited therein. In Wagner, the indicating assembly includes only lights 32 and 34 (Fig. 4). In Winston, the only switches provided outside the room are switches 15 and 19, which activate the bell

13, but are not used to determine the condition of the room with the condition being displayed. Accordingly, for at least this additional reason, the Examiner's rejection of claim 16 and claims 17-27 which depend therefrom, under 35 U.S.C. 103(a) as being unpatentable over Wagner in view of Winston should be reconsidered and withdrawn.

While claim 18 should be allowable as depending from what should now be an allowable independent claim 1, claim 18 is also allowable as neither Wagner nor Winston, alone or in combination, teach or suggest that an occupancy condition of a room is determined *when said entry door switch detects a closed door and said passive infra-red device detects motion within said preset period of delay*. In Wagner, the activation of the security/alarm feature is by an electronic/membrane keypad. (Col. 5, lines 30-31) Operation of the security/alarm feature is further described:

The alarm switch input will come either from an existing alarm sensor 56 (if any), *or from a newly installed door proximity switch or from a motion sensor*. (Col. 5, lines 33-35, emphasis added)

When the door switch *or* the motion sensor is activated, the microprocessor will set the outside "do not disturb" light to blink, or will display a different discreet message either via a separate light or via LCD panel. (Col. 5, lines 38-41, emphasis added)

Once the security feature is activated, triggering of the proximity switch *or* the motion sensor will result in sending of an alarm signal ... (Col. 5, lines 44-46, emphasis added)

As a further aspect of the invention, the switching of the unit to "do not disturb" for example, could activate a time-delayed motion sensor connected to the door to sense whether the room has been entered after the guest has departed... (Col. 5, lines 57-61)

Thus, Wagner describes a system that is activated by an electronic/membrane keypad, and is triggered by either a motion sensor or door switch. Wagner, alone or in combination with Winston, fails to teach or suggest that an occupancy condition of a room is determined *when said entry door switch detects a closed door and said passive infra-red device detects motion within said preset period of delay*, as claimed by Applicants. The use of both the door switch and the passive infra-red device eliminates the need for the electronic/membrane keypad taught by Wagner. Accordingly, for at least this additional reason, the Examiner's rejection of claim 18 under 35 U.S.C. 103(a) as being unpatentable over Wagner in view of Winston should be reconsidered and withdrawn.

While claim 19 should be allowable as depending from what should now be an allowable independent claim 1, claim 19 is also allowable as neither Wagner nor Winston, alone or in combination, teach or suggest actuating a minibar access condition when said minibar door switch detects an open minibar door indicative of minibar access, as recited in Applicant's claim 19. Indeed, neither Wagner nor Winston mention a minibar. As described in Applicant's specification, a mini-bar is a convenient store of goods within each room, usually within a refrigerator, that can be accessed by the occupant at his or her discretion. The Examiner alleges that the switch 12 of Wagner can be considered a minibar switch; however, Applicants respectfully disagree because Wagner does not teach or suggest that the switch 12 "detects an open minibar door indicative of minibar access", as is recited in claim 19. Accordingly, for at least this additional reason, the Examiner's rejection of claim 19 under 35 U.S.C. 103(a) as being unpatentable over Wagner in view of Winston should be reconsidered and withdrawn.

While claim 20 should be allowable as depending from what should now be an allowable independent claim 1, claim 20 is also allowable as neither Wagner nor Winston, alone or in combination, teach or suggest a system wherein a condition of occupancy is queried by employing a switch in one manner to display one condition, while a condition of minibar access is queried by employing the switch in another manner to display another

condition. As neither Wagner nor Winston mention a minibar, they cannot teach or suggest a switch that can be operated in two different ways to determine occupancy and minibar access. Accordingly, for at least this additional reason, the Examiner's rejection of claim 20, and claims 21-27 which depend therefrom, under 35 U.S.C. 103(a) as being unpatentable over Wagner in view of Winston should be reconsidered and withdrawn.

While claim 31 should be allowable as depending from what should now be an allowable independent claim 1, claim 31 is also allowable as neither Wagner nor Winston, alone or in combination, teach or suggest a switch assembly comprising an electronic thermostat. Neither Winston nor Wagner discuss an electronic thermostat. Accordingly, for at least this additional reason, the Examiner's rejection of claim 31 under 35 U.S.C. 103(a) as being unpatentable over Wagner in view of Winston should be reconsidered and withdrawn.

While claim 35 should be allowable as depending from what should now be an allowable independent claim 1, claim 35 is also allowable as neither Wagner nor Winston, alone or in combination, teach or suggest a system wherein when an "on" position is selected, all incoming telephone calls to the room are routed to voicemail. The Examiner alleges that Wagner discloses that a communication system connected from the occupant of the room and the remote location for communicating may include a telephone controlled by the microprocessor (52), citing Col. 2, lines 61-63, Col. 3, lines 34-44 and Col. 5, lines 4-25 of Wagner. However, Applicants respectfully disagree that the cited sections support the Examiner's allegation. Col. 2, lines 61-63 of Wagner state that the system may convey messages remotely and may receive remote instructions, to allow communications between the system and a remote hotel staff office. Similarly, Col. 5, lines 4-25 of Wagner recite that the switch 12 may be wired to send electrical signals to a remote location. It is further discussed that these signals are used by housekeeping staff to monitor the rooms for "maid service" messages. There is no mention of the switch 12 being connected to a phone system. Col. 3, lines 34-44 of Wagner merely recite that the switch assembly 10 may be located near a phone. It does not teach or suggest that the

switch assembly 10 in any way interacts with the phone. In sum, there is no teaching or suggestion in either Wagner nor Winston of a system wherein when an "on" position is selected, all incoming telephone calls to the room are routed to voicemail. Accordingly, for at least this additional reason, the Examiner's rejection of claim 35 under 35 U.S.C. 103(a) as being unpatentable over Wagner in view of Winston should be reconsidered and withdrawn.

New claim 37 incorporates some of the limitations of original claims 1, 16 and 19. Neither Wagner nor Winston, alone or in combination, teach or suggest actuating a minibar access condition when said minibar door switch detects an open minibar door indicative of minibar access, as recited in Applicant's new claim 37. Indeed, neither Wagner nor Winston mention a minibar. As described in Applicant's specification, a mini-bar is a convenient store of goods within each room, usually within a refrigerator, that can be accessed by the occupant at his or her discretion. The Examiner alleges that the switch 12 of Wagner can be considered a minibar switch; however, Applicants respectfully disagree because Wagner does not teach or suggest that the switch 12 "detects an open minibar door indicative of minibar access", as is recited in claim 37. In view of the foregoing, claim 37 and dependent claims 38-56 patentably define over Wagner in view of Winston. Consideration and allowance of new claims 37-56 are respectfully requested.

New claim 57 incorporates some of the limitations of original claims 1, 16, 17, and 18. Neither Wagner nor Winston, alone or in combination, teach or suggest that an occupancy condition of a room is determined *when both said entry door switch detects a closed state of the entry door and said passive infra-red device detects motion within a delay*. In Wagner, the activation of the security/alarm feature is by an electronic/membrane keypad. (Col. 5, lines 30-31) Operation of the security/alarm feature is further described:

The alarm switch input will come either from an existing alarm sensor 56 (if any), *or* from a newly installed door proximity switch or from a motion sensor. (Col. 5, lines 33-35, emphasis added)

When the door switch *or* the motion sensor is activated, the microprocessor will set the outside "do not disturb" light to blink, or will display a different discreet message either via a separate light or via LCD panel. (Col. 5, lines 38-41, emphasis added)

Once the security feature is activated, triggering of the proximity switch *or* the motion sensor will result in sending of an alarm signal ... (Col. 5, lines 44-46, emphasis added)

As a further aspect of the invention, the switching of the unit to "do not disturb" for example, could activate a time-delayed motion sensor connected to the door to sense whether the room has been entered after the guest has departed... (Col. 5, lines 57-61)

Thus, Wagner describes a system that is activated by an electronic/membrane keypad, and is triggered by either a motion sensor *or* door switch. Wagner, alone or in combination with Winston, fails to teach or suggest that an occupancy condition of a room is determined *when both said entry door switch detects a closed state of the entry door and said passive infra-red device detects motion within a delay* as claimed by Applicants. The use of both the door switch and the passive infra-red device eliminates the need for the electronic/membrane keypad taught by Wagner. In view of the foregoing, claim 57 and dependent claims 58-77 patentably define over Wagner in view of Winston. Consideration and allowance of new claims 57-77 are respectfully requested.

New claim 78 incorporates some of the limitations of original claims 1 and 16. Neither Wagner nor Winston, alone or in combination, teach or suggest an indicating assembly

that includes a switch actuated from outside of the room to determine a condition of the room, as recited in new claim 78. In Wagner, the indicating assembly includes only light 32 and 34 (Fig. 4). In Winston, the only switches provided outside the room are switches 15 and 19, which activate the bell 13, but are not used to determine the condition of the room with the condition being displayed. In view of the foregoing, claim 78 and dependent claims 79-100 patentably define over Wagner in view of Winston. Consideration and allowance of new claims 78-100 are respectfully requested.

CONCLUSION

It is believed that the foregoing remarks fully comply with the Office Action and that claims 1-10 and 12-100 are allowable. Accordingly, reconsideration and allowance is requested. The Examiner is cordially invited to contact the undersigned by telephone to expedite the allowance of this application.

If there are any charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1430 maintained by Applicants' attorneys.

Respectfully submitted,
BUCKINGHAM ET AL.

CANTOR COLBURN LLP
Applicants Attorneys

By: 

Philmore H. Colburn II
Registration No. 35,101

Date: June 12, 2003
Address: 55 Griffin Road South, Bloomfield, CT 06002
Telephone: (860) 286-2929
Cust. No: 023413